

### **REMARKS**

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

### **Status of Claims**

Claims 1-38 are pending in this application. Claims 14-15, 27 and 28 have been withdrawn from consideration. Claims 1-13, 16-26 and 29-38 are rejected. Claims 2, 4 and 6 have been cancelled without prejudice. Claims 1, 5, 17, 22 and 33-35 have been amended herein. Applicants respectfully assert that the amendments to the claims add no new matter.

### **INFORMATION DISCLOSURE STATEMENT**

The Examiner's comments on the Information Disclosure Statements (IDSs) are noted. Applicants plan on filing an IDS correcting these issues shortly.

### **CLAIM REJECTIONS**

#### **35 U.S.C. § 112 Rejection**

In the Office Action, the Examiner rejected claim 7 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse the rejection.

Applicants have herein amended independent claim 1 to recite an in-vivo device comprising a sensor, and have amended claim 7 (depending from independent claim 1) to include a sensor. Therefore, Applicants request that the Examiner withdraw the 35 U.S.C. § 112 rejection.

#### **35 U.S.C. § 102 Rejections**

##### *Kosaka*

In the Office Action, the Examiner rejected claims 1-3, 7-9, 12-13, 16-20, 22-23,

26, 29 and 31-38 under 35 U.S.C. § 102(b) as being anticipated by Kosaka et al. (JP 06-114036). Applicants respectfully traverse the rejection.

Kosaka et al. teach a device capable of attaching itself to a body cavity wall to perform medical diagnosis and/or treatment. (See paragraph [0006]). Kosaka et al. disclose an immobilizer comprising electromagnetic grabbers to clamp on to the lumen wall. (See paragraph [0014]).

Each of Applicants' amended independent claims 1 and 17 recites (with variation in brackets):

a sensor and a degradable [immobilizer or immobilization unit], said sensing device to collect data relating to changes in in-vivo environmental conditions, said sensing device to transmit said data, and said [immobilizer or immobilization unit] capable of being activated in response to a signal, wherein said signal is issued in response to an environmental condition related to said data

Each of Applicants' amended independent claims 22 and 33 recites (with variation in brackets):

sensing, [in] an in-vivo device, data relating to a change in in-vivo environmental conditions;  
transmitting said data;  
generating a signal in response to an environmental condition related to said data to activate a degradable immobilizer attached to [the] in vivo device;

Applicants assert that Kosaka et al. do not teach that the immobilizer is activated in response to a signal generated based on data collected by a sensing device. Activation in response to a signal generated based on data collected by a sensing device is discussed in more detail below, in the discussion of the Meron reference.

Therefore, Applicants assert that independent claims 1, 17, 22 and 33 are allowable over Kosaka. Each of claims 3, 7-9, 12-13, 16, 18-20, 23, 26-29, 31-32 and 34-38 depends from one of independent claims 1, 17, 22 and 32, respectively, and includes all the limitation of those claims and are therefore allowable. Claims 2, 4 and 6 have been cancelled. Therefore, Applicants request that the Examiner withdraw the

rejection of claims 1-3, 7-9, 12-13, 16-20, 22-23, 26, 29 and 31-38 under 35 U.S.C. § 102(b) as being anticipated by Kosaka.

Meron

In the Office Action, the Examiner rejected claims 1-10, 16-24 and 29-38 under 35 U.S.C. § 102(e) as being anticipated by Meron et al. (U.S. Patent Application Publication No. 2002/0042562, "Meron"). Applicants respectfully traverse the rejection.

Meron teaches an in-vivo device for monitoring a site within the body. (See abstract). The device of Meron is designed to be inserted into a body lumen by a surgeon at the end of a procedure in order to monitor the surgical site. (See paragraphs [0011] and [0029]).

The Examiner asserts that Meron discloses that a surgeon is able to perform immobilization in response to a detected in-vivo environmental condition, citing to Meron paragraphs [0027], [0029], and [0037].

Meron teaches a device designed to be immobilized during surgery by the process of sewing the device to a lumen wall using a suture. Paragraph [0029] of Meron discusses a surgeon sewing the device to body tissue to immobilize the capsule, but does not discuss why the surgeon decides to sew the device at a particular time or place. Paragraph [0027] of Meron discusses transmitting in-vivo information to a processor, but this in-vivo information is not used to control a surgeon sewing the device to body tissue. Paragraph [0039] describes that a device may be delivered to a particular site via endoscope and then immobilized, but paragraph [0039] does not state that the immobilization is in response to a signal or in response to sensed data.

Thus Meron cannot teach the above-quoted limitations of 1, 17, 22, and 23 of, in response to an environmental condition activating an immobilizer. Disclosure that a doctor immobilizes a device with a sensor does not teach or suggest the limitations of in response to an environmental condition activating an immobilizer.

While the Examiner claims that the immobilizer of Meron can be activated by a signal from outside the body, it is clear from the disclosure of Meron that the device is incapable of immobilizing itself in response to any signal. For example, the embodiment

of paragraph [0035] of Meron discloses that a battery inside the in-vivo device may cause a change of shape of a knot to immobilize the device, but neither this nor any other section of Meron describes immobilization in response to a signal from outside the body. The portion of Meron to which the Examiner cites, paragraph [0029], describes the device being immobilized to the body lumen by hand, and not an immobilizer being activated in response to a signal from outside the body. A surgeon cannot be said to be equivalent to a "degradable immobilizer."

Applicants assert that, based on the above arguments and amendments, Meron does not anticipate any of claims 1, 17, 22, and 23. Claims 2, 4 and 6 have been cancelled. Each of claims 3, 5, 7-10, 16, 18-21, 23, 24 and 29-38 depends from one of claims 1, 17, 22, and 23, includes the limitations of the claim from which it depends, and is therefore likewise allowable.

Applicants request that the Examiner withdraw the rejection of claims 1-10, 16-24 and 29-38 under 35 U.S.C. § 102(e) as being anticipated by Meron.

In the Office Action, the Examiner rejected claims 1, 10-11, 17-18, 22 and 24-25 under 35 U.S.C. § 102(b) as being anticipated by Hugemann et al. (U.S. Patent No. 4,425,117, "Hugemann"). Applicants respectfully traverse this rejection.

Hugemann teaches a device for releasing substances at a defined location in the alimentary canal. (See abstract). The Examiner asserts that Hugemann discloses an immobilizer (20, "lower part" of the capsule) wherein a fuse (9) reacts to a signal from a high frequency transmitter to release a spring which ultimately causes immobilization of the device, citing to the Abstract and col. 3, line 31 to col. 4, line 14.

In the Abstract of Hugemann and in col. 3, line 31 to col. 4, line 14, no immobilization of the device is discussed. Rather, a series of components (a fuse, a spring, a balloon, etc.) act to release a substance from the device. Element 20 is not an immobilizer, but rather a portion of the shell of the device (Fig. 2).

Applicants assert that Hugemann does not teach the above-quoted limitations of Applicants' amended independent claims 1, 17 and 22 and therefore does not anticipate these claims. Each of claims 1, 10-11, 17-18, 22 and 24-25 depends from one of claims

APPLICANT(S): GILAD, Zvika et al.  
SERIAL NO.: 10/540,890  
FILED: February 23, 2006  
Page 9

1, 17 and 22, includes all the limitations of the claim from which it depends, and is therefore likewise allowable.

Applicants request that the Examiner withdraw the rejection of claims 1, 10-11, 17-18, 22 and 24-25 under 35 U.S.C. § 102(b) as being anticipated by Hugemann.

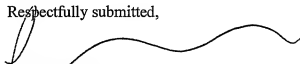
### Conclusion

In view of the foregoing amendments and remarks, Applicants assert that the pending claims are allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, or if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to contact the undersigned at the telephone number below.

No fees are believed to be due in connection with this paper. However, if any such fees are due, please charge any fees that are due to deposit account No. 50-3355.

Respectfully submitted,



Caleb Pollack  
Attorney/Agent for Applicants  
Registration No. 37,912

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**Pearl Cohen Zedek Latzer, LLP**  
1500 Broadway, 12th Floor  
New York, New York 10036  
Tel: (646) 878-0800  
Fax: (646) 878-0801